



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,042	10/22/2001	Roger Biel	CL/V-31641A	8043

1095 7590 01/28/2003

THOMAS HOXIE
NOVARTIS, PATENT AND TRADEMARK DEPARTMENT
ONE HEALTH PLAZA 430/2
EAST HANOVER, NJ 07936-1080

EXAMINER

CHAPMAN JR, JOHN E

ART UNIT	PAPER NUMBER
----------	--------------

2856

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,042

Applicant(s)

BIEL ET AL.

Examiner

John E Chapman

Art Unit

2856

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 7, 9-11, 13, 14, 17-20 and 24 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 6, 8, 12, 15, 16, 21-23, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2856

DETAILED ACTION

1. The disclosure is objected to because of the following informalities: The specification should be self-contained and should not refer to the claims, as on page 2, lines 1-3. Note that the claims may be amended or cancelled. Appropriate correction is required.

2. Claims 2, 11 and 23 are objected to because of the following informalities:

It is not clear that claim 2 further limits claim 1. In particular, it is not clear that the lens can be sonicated with ultrasound (claim 1) without the ultrasonic processor emitting ultrasonic power (claim 2). Note also that "processes" in line 1 should be changed to --processor--.

It is not clear that claim 11 further limits claim 10. In particular, it is not clear that there is any difference between an ultrasonic field (claim 10) and an ultrasonic power field (11).

Regarding claim 23, it would appear that "24" should be changed to --25-- in view of page 2, paragraph 5, and claims 6 and 16.

Clarification and/or correction is required.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2856

4. Claims 1-2, 4, 7, 9-11, 13-14, 17-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bui.

Bui discloses a method of measuring the thickness of an optical lens wherein a liquid 50 is placed on the specimen 60 and the specimen is exposed to an ultrasonic field.

Regarding claim 1, delay line 30 comprises a sonotrode. Accordingly, the only difference between the claimed invention and the prior art consists in placing an ophthalmic lens in a holding container filled with a test fluid. Regarding an ophthalmic lens, it would have been obvious to use the device of Bui to measure the thickness of any type of optical lens. Regarding a holding container, it is well known in the art to immerse a specimen in a container filled with a test fluid in order to ensure liquid coupling. Accordingly, merely to select an ophthalmic lens and place it in a holding container would have been obvious to one having ordinary skill in the art.

Regarding claims 4 and 7, the choice of a particular size and shape is generally recognized as being within the level of ordinary skill in the art. See *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 9, it would have been an obvious design expedient to provide a sealing sleeve in order to prevent spilling.

Regarding claim 10, the only difference between the claimed invention and the prior art consists in placing an ophthalmic lens in a test liquid and inspecting for defects. Regarding an ophthalmic lens, it would have been obvious to use the method of Bui to inspect any type of optical lens. Regarding placing the lens in a test fluid, it is well known in the art to immerse a

Art Unit: 2856

specimen in a test fluid in order to ensure liquid coupling. Regarding inspecting the lens for defects, it would have been obvious to inspect the lens for defects in its thickness.

Regarding claims 13, delay line 30 comprises a sonotrode.

Regarding claims 14 and 17, note the above remark regarding claims 4 and 7.


Regarding claims 19, 20 and 24, it would have been obvious to use the device of Bui to measure the thickness of any type of optical lens, including contact lenses.

5. Claims 3, 5-6, 8, 12, 15-16, 21-23 and 25-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Browning et al. discloses an apparatus for ultrasonic cleaning and sterilization of soft contact lenses.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Chapman whose telephone number is (703) 305-4920.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.


JOHN E. CHAPMAN
PRIMARY EXAMINER